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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,911	11/21/2003	Bryan M. Kelly	BLLYP001.US13	4013

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TECHNOLOGY & INTELLECTUAL PROPERTY
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EXAMINER

HSU, RYAN

ART UNIT PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/719,911	Applicant(s) KELLY ET AL.	
	Examiner Ryan Hsu	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected on the ground of nonstatutory double patenting over claims 1-77 of U. S. Patent No. US 5,816,918 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '918 a method and game apparatus that provides a prize redemption system. The system comprises a game processor for controlling a game of skill on the game apparatus when a player receives a monetary input from a player. Furthermore, it provides a means for providing a prize selection menu presenting a plurality of prizes wherein the prizes have been determined based

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upon a “prize credit cost” which has been determined in accordance with a desired payout value of an operator of the game apparatus. Furthermore, the prize selections are made by a “prize output device coupled to said the game processor for outputting an indication of said selected prize to said player such that said player may use said indication to redeem said selected prize. The claims of the instant application are directed towards a plurality of physically separated player-machines which each include its own CPU and software for allowing a player to play at least one game that requires sufficient skill (*ie: game processor and game of skill*). And an “award server including a CPU and software physically separated from the player-machines for digital communication therewith, wherein the communication includes game information and award information associated with said at least one game (*ie: prize output device coupled to said game processor*). As the limitations and elements of the previous U.S. patent are functionally equivalent to the claims of the instant application it would have been obvious to one of ordinary skill in the art at the time the invention that these two sets of claims are not patentably distinct from one another.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Objections

Claim 1 is objected to because of the following informalities: applicant has spelled the word sufficient as “sufficient”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (US 5,816,918).

Regarding claim 1, Kelly et al. discloses a game system, the game system comprising: a plurality of physically separated player-machines, wherein each physically separated player-machine includes its own CPU and software for allowing a player to play at least one game that requires sufficient skill such that it is not primarily a game of chance (*see games [272] of Fig. 5a and the related description thereof*), wherein the player is entitled to play at least one game due to an economic consideration and is adapted for developing digital information resulting from play of the at least one game (*see monetary input [104] of Fig. 3 and the related description thereof*). Additionally, Kelly discloses an award server that includes a CPU and software, physically separated from the plurality of player-machines and coupled with the plurality of player-machines for digital communication therewith, wherein the digital communication includes game information and award information associated with at least one game (*see server [108] and prize selection unit [11] of Fig. 3 and the related description thereof*).

Regarding claim 9, Kelly et al. discloses a method for a game system comprising: allowing a player to play at least one game that requires sufficient skill such that at least one game is not primarily a game of chance (*see games [272] of Fig. 5a and the related description thereof*), and at least one game being played on one of a plurality of

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physically separated player-machines in a game system (*see Fig. 2-3 and the related description thereof*). Additionally, Kelly's method discloses wherein each of the plurality of physically separated player-machines is adapted to develop digital information resulting from play of at least one game and for being in digital communication with other physically separated player-machines, wherein the player is entitled to play at least one game due to an economic consideration (*see 'monetary input' [104] of Fig. 3 and the related description thereof*). Furthermore, Kelly's system discloses digitally communicating with an award server including its own CPU and software by a plurality of physically separated player-machines wherein the award server is physically separated from the plurality of physically separated player-machines and the digital communication includes game information and award information associated with at least one game (*see server [108] of Figs 3-4 and the related description thereof*).

Regarding claims 2 and 10, Kelly discloses a system wherein the digital communication is over a network wherein the plurality of player-machines is coupled to the award server (*see Figs. 3-4 and the related description thereof*).

Regarding claims 3-4 and 11-12, Kelly discloses a system wherein the network includes various options to allow for networked communication between the different devices. As disclosed by Kelly, network device [24] can be implemented as any one of many devices well known to those skilled in the art such as a network interface card coupled to a main bus of the system, a telephone modem, a cable modem, a direct network connection or other device for communicating information according to standard network or modem protocols (*see col. 12: ln 30-40*). Therefore Kelly discloses a system wherein the network communication device inherently uses a common serial transmission

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protocol and thus it would encompass implementation of the standard protocol known as RS-232 (*in arguendo please refer to wikipedia's definition of RS-232 as a standard serial protocol that is used for communication in modems*).

Regarding claim 5, Kelly discloses an award server that provides awards based on one or more criteria, selected from a group consisted of: a game result; a progressive score; a completion of a specific task; an attainment of a specific goal; and a number of players playing (*see col. 15: ln 25-44*).

Regarding claim 6, Kelly discloses a game system wherein the progressive score is associated with a progressive bonus that is based on contributions made by a plurality of physically separated player-machines, and wherein the progressive score can be incremented or decremented based on a multiplier associated with the contributions (*see col. 20: ln 16-col. 21: ln 48*).

Regarding claim 7, Kelly discloses a game system wherein the contributions are based on one or more events comprising: consideration generated from at least one of the plurality of physically separated player-machines (*see col. 16: ln 20-67*); and attainment of at least one of the plurality of physically separated player-machines; and attainment of at least one pre-determined goal by at least one player playing at the plurality of physically separated player-machines (*see Figs. 5 and 7 and the related description thereof, col. 18: ln 22-37*).

Regarding claim 8, Kelly discloses a game system wherein the award server provides non-monetary awards (*see col. 15: ln 26-44*).

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kelly et al. (US 5,882,258) - Skill-Based Card Game.

Allard et al. (US 5,733,193) - Boxing Arcade Game.

Sitrick (US 4,572,509) – Video Game Network.

Eiba (US 5,855,516) - Method and System for Automatic Running of Tournaments.

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached at (571)-272-6788.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).



RH

March 15, 2007

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A handwritten signature in black ink, reading "Scott E. Jones". The signature is written in a cursive style with a large, stylized "S" and "J".

SCOTT JONES
PRIMARY EXAMINER